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Mail Stop Appeal Brief-Patents

In re application of: Ken HIRUNUMA et al.

Attorney Docket No. P24122

Application No. : 10/700,496

Group Art Unit : 2872

Filed : November 5, 2003

Examiner : Joshua L. Pritchett

For : DIGITAL-CAMERA-PROVIDED BINOCULARS

Mail Stop Appeal Brief-Patents

Commissioner for Patents

U.S. Patent and Trademark Office

Customer Service Window, Mail Stop Appeal Brief-Patents

Randolph Building

401 Dulany Street

Alexandria, VA 22314

Sir:

Transmitted herewith is an **Appeal Brief under 37 C.F.R. § 41.37** in the above-captioned application.

- Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
 A Request for Extension of Time.
 No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 7	*20	0	x25=	\$	x 50=	\$ 0.00
Indep. Claims: 1	**3	0	x100=	\$	x200=	\$ 0.00
Multiple Dependent Claims Presented			+180=	\$	+360=	\$ 0.00
Extension Fees for one Month(s)				\$		\$ 0.00
Appeal Brief Filing Fee						\$500.00
* If less than 20, write 20 ** If less than 3, write 3			Total:	\$	Total:	\$500.00

Please charge my Deposit Account No. 19-0089 in the amount of \$_____.

A check in the amount of \$500.00 to cover the filing fee is included.

The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

Any additional filing fees required under 37 C.F.R. 1.16.

Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Ken HIRUNUMA et al. Group Art Unit : 2872
 Appl. No. : 10/700,496 Examiner : PRITCHETT, J.
 Filed : November 5, 2003 Confirmation No. : 6278
 For : DIGITAL-CAMERA-PROVIDED BINOCULARS

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Commissioner for Patents
 U.S. Patent and Trademark Office
 Customer Service Window, Mail Stop Appeal Brief- Patents
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Sir:

This appeal is from the Examiner's final rejection of claims 1-7 as set forth in the Final Official Action of October 18, 2005, and as set forth in the Notice of Panel Decision from Pre-Appeal Brief Review of February 1, 2006.

No amendments have been filed subsequent to the final rejection of the above-noted claims.

The requisite fee under 37 C.F.R. § 41.20(b)(2) in the amount of \$ 500.00 for the filing of the Appeal Brief, is being paid by check, submitted herewith. However, if for any reason the necessary fee is not associated with this file, the Commissioner is authorized to charge the fee for the Appeal Brief and any necessary extension of time fees to Deposit Account No. 19-0089.

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TABLE OF CONTENTS

- I. Real Party in Interest** begins on page 3 of this paper.
- II. Related Appeals and Interferences** begins on page 4 of this paper
- III. Status of the Claims** begins on page 5 of this paper
- IV. Status of the Amendments** begins on page 6 of this paper
- V. Summary of the Claimed Subject Matter** begins on page 7 of this paper
- VI. Grounds of Rejection to be Reviewed on Appeal** begins on page 9 of this paper
- VII. Argument** begins on page 10 of this paper
- Claims Appendix** begins on page 17 of this paper
- Evidence Appendix** begins on page 18 of this paper.
- Related Proceedings Appendix** begins on page 19 of this paper.

REAL PARTY IN INTEREST

The real party in interest is PENTAX Corporation, by virtue of an assignment recorded in the U.S. Patent and Trademark Office on November 5, 2003, at Reel 014685 and Frame 0162.

II. RELATED APPEALS AND INTERFERENCES

NONE - No related appeals and/or interferences are pending.

III. STATUS OF THE CLAIMS

Claims 1-7, stand finally rejected and are the subject of this Appeal.

Claims 1-7 remain pending in the present application.

IV. STATUS OF THE AMENDMENTS

As noted *supra*, no amendments have been filed subsequent to the final rejection of October 18, 2005.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

As described in Applicants' specification beginning, *inter alia*, page 2, line 1, known digital cameras and digital binoculars are often equipped with microphones on the object side (*i.e.*, objective lens-provided side) or on the upper surface of the device, to better record the sounds of an object being observed. However, as noted in Applicants' Response filed on August 19, 2005 (all arguments made therein being expressly incorporated herein), the present invention is useful for bird-watching, and as such, a microphone located on a bottom surface, or underside, of the binoculars is positioned closer to the user's mouth so that the user need not amplify his/her voice to ensure sound recordation, which may otherwise (as with conventional digital camera-equipped binoculars) scare birds away.

A feature of the invention thus provides digital-camera-provided binoculars that can easily perform fine voice recording while carrying out telescopic binocular observations.

In particular, the following descriptions are made with respect to the independent claim and include references to particular parts of the specification. As such, the following are merely exemplary and are not a surrender of other aspects of the present invention that are also enabled by the present specification and that are directed to equivalent structures or methods.

Independent claim 1 is directed to digital-camera-provided binoculars having a digital camera that is able to capture an image of an object which is

P24122.A07

observed through optical systems of the binoculars (page 8, lines 11-15), and a microphone provided on a bottom face of the binoculars (page 7, lines 11-13).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- (A) Whether claims 1 and 3-6 are properly rejected under 35 U.S.C. § 102(e) as unpatentable over U.S. Patent Publication No. 2005/0018048 to WU (hereinafter WU).
- (B) Whether claim 2 is properly rejected under 35 U.S.C. §103(a) as being unpatentable over WU in view of U.S. Patent Publication No. 2003/0063189 to HIRUNUMA (hereinafter HIRUNUMA).
- (C) Whether claim 7 is properly rejected under 35 U.S.C. §103(a) as being unpatentable over WU in view of Japanese Patent Publication No. 08-098209 to NAGUMO (hereinafter NAGUMO).

VII. ARGUMENT

(A) The rejection of claims 1 and 3-6 under 35 U.S.C. § 102(e) as being anticipated by WU is in error, the decision to reject these claims on this ground should be reversed, and the application should be remanded to the Examiner for allowance.

Independent Claim 1

With respect to claim 1 (the only rejected independent claim), the Examiner has asserted that "WU discloses a digital camera provided binoculars . . . wherein the microphone is provided one [sic, "on"] a bottom face of the binoculars."¹ The Examiner attempts to support his position by further asserting that "Figure 1 shows the digital camera (2), which is also the microphone on a bottom face of the binoculars" and that "[t]he WU reference does not disclose whether this is the top or bottom face." The Examiner continues by indicating that he interprets WU "to allow the digital camera (2) to be located on either the top or the bottom face depending on the user's preference to actuate the buttons (22 and 23) with either an index finger or a thumb."

In Applicants' Response, Applicants asserted that Fig. 1 of WU shows the device in its intended upright position, and it is not reasonable to assume that a user would turn the WU device upside down to use it, any more than it would be for a user to turn a digital camera or a pair of binoculars upside down and use them. For example, when a digital imaging device is turned upside down, the "status indicators" (e.g., exposure setting, number of images remaining, etc.) viewed on the display will also be upside down.

¹ Applicants note that the newly-cited BOYS reference (U.S. Patent Publication No. 2002/0069070) obliquely refers to a microphone (not shown) "mounted in a convenient location."

Nevertheless, in the “Response to Arguments” section of the Final Official Action, the Examiner notes that “Fig. 4 of WU shows that the input module includes both the CCD sensor and the microphone, therefore the microphone would be within the structure labeled 2 in Fig. 1” and again maintains that it “does not appear to be unreasonable” to use the digital camera/binocular of WU in an upside down position. Lastly, the Examiner asserts that “if the Applicant’s arguments were held to be persuasive any person who happened to pick up the WU binoculars upside down would be infringing on the applicant’s patent.”

Applicants again traverse the Examiner’s rejection of the pending claims. Initially, contrary to the Examiner’s assertion (and as noted in Applicants’ previous Response), Applicants note that WU completely fails to disclose the location of the microphone in relation to the binoculars. For example, paragraphs [0021] and [0022] of WU (identified by the Examiner) merely note that image/audio signal compression and storage parts are located in the digital storage unit 2, shown on top of the binoculars in Fig. 1. Neither the specification nor the drawings of WU discloses the claimed location of the microphone, and a proper rejection cannot be based on teachings in a reference that are vague or based on conjecture. See *Datascope Corp. v. SMEC, Inc.*, 776 F.2d 320, 227 USPQ 838 (Fed.Cir. 1985). Further, it is well settled that an anticipation rejection cannot be predicated on an ambiguous reference. See *In re Turlay*, 304 F.2d 893, 134 USPQ 355 (CCPA 1962). Thus, Fig. 1 does not “show the digital camera (2), which is also the microphone on a bottom face of the binoculars.”

Secondly, Applicants again maintain that the *reasonable* interpretation of WU is that the binoculars are intended to only be used in the upright position (in relation to a user's face) as shown in Fig. 1. Since WU is silent as to the positional relationship of the binoculars of Fig. 1, it is reasonable to conclude that the binoculars are shown in its intended upright position (in relation to the user's face). With respect to the Examiner's assertion that "any person who happened to pick up the WU binoculars upside down would be infringing on the applicant's patent," Applicants note that mere assertions cannot change realities, and thus merely turning an object upside down does not make the bottom surface the top surface, and vice-versa. For example, if the Examiner were to turn the WU device around to take a self-portrait, the front end does not become the back end, and vice-versa.²

Even if it could be considered reasonable to use the WU device in a position upside-down from Fig. 1, WU still does not teach or suggest that the microphone would be on the bottom surface. For example, Fig. 1 shows the imaging lens 21 on a *front* surface of the binoculars. Under the Examiner's reading of WU (*i.e.*, that "the input module includes both the CCD and the microphone, therefore the microphone would be within the structure labeled 2"), then WU's microphone would also be on the front surface of the WU binoculars, and as such, would still be on the front surface of the binoculars regardless of whether the device was used upside down or right side up.

² Perhaps this point was best illustrated by a quote attributable to Abraham Lincoln during the Lincoln-Douglas debates of 1858. Lincoln posited "How many legs does a dog have if you call the tail a leg?" His answer- "Four. Calling a tail a leg doesn't make it a leg."

Thus, Applicants submit that WU fails to teach or suggests the features recited in at least independent claim 1, and is thus patentable under at least 35 U.S.C. § 102(e).

Dependent Claim 3

With respect to the Examiner's rejection of dependent claim 3, since this claim is dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, this dependent claim is also allowable for at least these reasons. Further, Applicants submit that the applied reference fails to teach or suggest at least that sound information collected by the microphone is recorded in association with an image captured by the digital camera, as generally recited in claim 3.

Dependent Claim 4

With respect to the Examiner's rejection of dependent claim 4, since this claim is dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, this dependent claim is also allowable for at least these reasons. Further, Applicants submit that the applied reference fails to teach or suggest at least that recording using the microphone is carried out just after an image capturing operation of the digital camera, as generally recited in claim 4.

Dependent Claim 5

With respect to the Examiner's rejection of dependent claim 5, since this claim is dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, this dependent claim is also allowable for at least these reasons. Further, Applicants submit that the applied reference fails to teach or suggest at least that the microphone is positioned on the bottom face and in the vicinity of a rear face where ocular lenses of the binoculars are provided, as generally recited in claim 5.

Dependent Claim 6

With respect to the Examiner's rejection of dependent claim 5, since this claim is dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, this dependent claim is also allowable for at least these reasons. Further, Applicants submit that the applied reference fails to teach or suggest at least that the microphone is positioned on the bottom face and between a pair of the optical systems of the binoculars, as generally recited in claim 6.

(B) The rejection of claim 2 under 35 U.S.C. § 103(a) over WU in view of HIRUNUMA is in error, the decision to reject this claim on this ground should be reversed, and the application should be remanded to the Examiner for allowance.

With respect to the Examiner's rejection of dependent claim 2, since this claim is dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, this dependent claim is also allowable for at least these reasons. Further, Applicants submit that it would not be obvious to include the tripod attaching section of HIRUNUMA into the same face of WU as the microphone (*i.e.*, the bottom face, which the Examiner has identified to be digital image storage unit 2, shown in Fig. 2 to be at the top of the binoculars).

(C) The rejection of claim 7 under 35 U.S.C. § 103(a) over WU in view of NAGUMO is in error, the decision to reject this claim on this ground should be reversed, and the application should be remanded to the Examiner for allowance.

With respect to the Examiner's rejection of dependent claim 7, since this claim is dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, this dependent claim is also allowable for at least these reasons. Further, Applicants submit that the applied reference fails to teach or suggest at least that the digital camera and the microphone are mounted on different surfaces of the binoculars, as generally recited in claim 7. For example, the camera portion of NAGUMO is designated as 1a and 1b (and not 2a-b as determined by the Examiner). As such the camera 1a, 1b and the microphone 5a, 5b of NAGUMO are located on the same (*i.e.*, the upper) surface, and not on different surfaces.

CONCLUSION

Claims 1 and 3-6 are patentable under at least 35 U.S.C. § 102(e) over WU, claim 2 is patentable under at least 35 U.S.C. § 103(a) over any proper combination of the teachings of WU and HIRUNUMA, and claim 7 is patentable under at least 35 U.S.C. § 103(a) over any proper combination of the teachings of WU in view of NAGUMO. Specifically, the applied art of record fails to teach or suggest the unique combination of features recited in Applicants' claims 1-7 for at least the reasons noted *supra*. Accordingly, Applicants respectfully request that the Board reverse the decision of the Examiner to reject claims 1-7 and remand the application to the Examiner for withdrawal of the rejection.

Thus, Applicants respectfully submit that each and every pending claim of the present application meets the requirements for patentability under at least 35 U.S.C. §§ 102 and 103, and that the present application and each pending claim are allowable over the prior art of record.

If there should be any questions about this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

March 10, 2006
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Attachments: Claims Appendix
Evidence Appendix
Related Proceedings Appendix

CLAIMS APPENDIX

1. Digital-camera-provided binoculars, comprising:
 - a digital camera that is able to capture an image of an object which is observed through optical systems of said binoculars; and
 - a microphone;

wherein said microphone is provided on a bottom face of said binoculars.
2. Binoculars according to claim 1, wherein said bottom face comprises a tripod attaching section to which a tripod is attached.
3. Binoculars according to claim 1, wherein sound information collected by said microphone is recorded in association with an image captured by said digital camera.
4. Binoculars according to claim 1, wherein recording using said microphone is carried out just after an image capturing operation of said digital camera.
5. Binoculars according to claim 1, wherein said microphone is positioned on said bottom face and in the vicinity of a rear face where ocular lenses of said binoculars are provided.
6. Binoculars according to claim 1, wherein said microphone is positioned on said bottom face and between a pair of said optical systems of said binoculars.
7. Binoculars according to claim 1, wherein said digital camera and said microphone are mounted on different surfaces of said binoculars.

P24122.A07

EVIDENCE APPENDIX

NONE

RELATED PROCEEDINGS APPENDIX

NONE